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Serial No. 10/700,762

PATENT APPLICATION

REMARKS

This is in full and timely response to the initial Office Action on the merits dated February 18, 2005. Reconsideration and reexamination are respectfully requested in view of the foregoing amendments and the following remarks.

By the foregoing amendment, claims 2, 4, 5, 7, 8, and 19-20 have been canceled and claims 1, 6, and 12 have been amended. Therefore, claims 1, 3, 6, and 9-18 remain in this application with claims 1 and 12 being independent.

IN THE CLAIMS:**35 U.S.C. § 102 Rejections:**

Claims 1, 3, 5, 9, and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 278,341 to Kelly. The applicant strongly disagrees with the examiner's conclusion that Kelly anticipates these claims for the following reasons. First, the preamble of claim 1 of the present application recites a kit for use in playing a golf and soccer-like game. Kelly, by contrast, regards a game similar to "croquet" and "15-ball pool." Virtually the only similarity between the game proposed by Kelly and the present invention is the use of a "mallet." The examiner admits that "Kelly discloses a kit for use in playing a golf game." (Office Action, page 2). As Kelly makes no disclosure of a "soccer-like game" component, the applicant submits that Kelly does not anticipate claims 1, 3, 5, 9, and 12. Without admitting the propriety of these rejections and as further described later in this response, claims 1 and 12 have been

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amended to more perfectly recite that the target ball is an element of the invention for being kicked. In other words, the soccer-like game element is now positively recited in the claims although the applicant believes it was at least implicitly recited originally.

Regarding claim 5, the examiner states that Kelly shows a ball having a plurality of
5 concentric regions. The applicant strongly disagrees with this interpretation of the drawings and disclosure in Kelly. Specifically, Fig. 1 of Kelly shows curved lines solely for the purpose of indicating roundness, e.g. that each object "a" is spherical, in a similar manner as the lines shown in Fig. 1 of the Obligio reference also cited in this Office Action. There is absolutely no disclosure in Kelly to suggest that each ball has "concentric regions . . . for indicating an
10 associated point value" as is affirmatively recited in the present application.

Without admitting the propriety of the rejections discussed above, claim 1 has been amended to include all of the limitations of claims 2 and 5 and claims 2 and 5 have been canceled. Claim 2, the rejection of which will be further discussed below, recites that the target ball includes a diameter that is larger than a diameter of the play ball." This is clearly not taught
15 by Kelly. The concentric regions recited in claim 5, when Kelly is accurately interpreted by its disclosure and drawings, also distinguish over Kelly. Therefore, claim 1, especially as amended, is clearly not anticipated by Kelly and applicant respectfully requests that the § 102(b) rejection thereof be withdrawn.

20 Regarding claim 12, the applicant again strongly disagrees with the examiner's reading of Kelly. First, the applicant incorporates by reference the remarks and arguments made above concerning the emphasis in the present invention on a soccer-like game and the lack of

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such a disclosure by Kelly. Second, the examiner states that Kelly discloses a club having a shaft and a club head *axially coupled* to a first end of said shaft. Then, the examiner states that Kelly also teaches means for selectively rotating said club head to a desired club face, namely that the means for rotating is the user's hand. This reading misses the clear recitation in the present claim 12 as illuminated by the original specification. In the present application, the club head is axially coupled to the shaft, i.e. it is coupled for movement about an axle. Kelly does not disclose this. Further, the "means for selectively rotating said club head" are specific mechanical elements recited in the specification. The means-plus-function claiming technique should be interpreted based on the specification. As Kelly, does not disclose any of these features, claim 12 is not *anticipated* thereby and the applicant respectfully requests that this 102(b) rejection be withdrawn.

Claims 19 and 20 stand rejected under 102(b) as being anticipated by U.S. Pat. No. 569,438 to Urquhart. Without admitting the propriety of these rejections, claims 19 and 20 have been canceled.

35 U.S.C. § 103 Rejections:

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Obligio, U.S. Pat. No. 4,799,666. First, the applicant urges that this rejection is based on an improper combination of references for all of the reasons stated above regarding Kelly. Namely, neither Kelly nor Obligio provide any disclosure, by text or drawing, regarding a golf and soccer-like game. Obligio does not disclose the use of a club to strike a play ball having

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one diameter into contact with a target ball of larger diameter. Neither reference discloses a target that is to be kicked in game play. Instead, Obligio teaches throwing the smaller ball into the larger ball, whereby to generate an explosion. The applicant contends that it would not have been obvious to one of ordinary skill in the art to combine the teaching of a two-ball explosion game (Obligio) with a croquet-like lawn pool game (Kelly) to arrive at a golf and soccer-like game having a plurality of balls of which a target ball includes concentric regions for point distinctions, golf-like club, and ball size variations. In other words, the applicant strongly urges that the very minimal similarities between the prior art references and the recited invention can not support the present rejections.

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Claims 7, 8, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of U.S. Pat. No. 3,829,092 to Arkin. Without admitting the propriety of this rejection and believing that this rejection should be withdrawn as being based on an improper combination as advanced previously, claim 1 has been amended to include all of the limitations of claims 7 and 8 and claims 7 and 8 have been canceled. Regarding, claim 15, the applicant reiterates his argument that this rejection is based on an improper combination of references, namely, that Kelly does not teach or suggest the elements of claim 12 from which claim 15 depends, whether considered singly or in combination with any other references. Therefore, the rejection of claim 12 should be withdrawn along with the rejection of claim 15.

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Claims 4 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kelly in view of Fogarty, U.S. Pat. No. 4,575,078. For all of the reasons discussed previously

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regarding the impropriety of the examiner's use of the Kelly reference, the applicant respectfully requests that the present rejections be withdrawn. Nevertheless, claim 1 has been further amended to include all of the limitations of claim 4 and claim 4 has been canceled. The applicant believes that it would be improper for the examiner to maintain or continue a rejection of claim 1
5 over the multiplicity of divergent art that has been raised in this prosecution. In other words, applicant does not believe it would have been obvious to one of ordinary skill in this art to combine all of these teachings to arrive at the invention now recited in claim 1, especially where the teachings in Kelly fail to closely approach the recited invention.

Regarding claim 16, however, the applicant urges that the rejection of claim 12, from
10 which claim 16 depends, be withdrawn for the reasons advanced previously and that claim 16, therefore, be allowed. Further, Fogarty teaches the use of "fuzzy material" for not damaging a tabletop surface. Fuzzy material is used in the present invention to improve the "feel" of a shot when impacted by a club head (Specification, page 4, lines 13-15). Therefore, the disclosure of fuzzy material in Fogarty for damage protection for a tabletop pool game would not have
15 suggested the use of fuzzy material for club head impact purposes as is recited in the present invention. The rejection over Fogarty, therefore, is improper and the applicant respectfully requests that it be withdrawn.

35 U.S.C. § 103 Rejections:

20 Claims 1-6, 9, 12, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mosier, U.S. Pat. No. 4,244,576. The applicant strongly disagrees with the underlying premise and reasoning for the selection and use of the Mosier reference and, for the

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following reasons, respectfully requests that this rejection be reconsidered and completely removed from the present examination of the above referenced claims. The examiner states that the applicant does not specifically state why it is "critical" to have the target on a ball in order to attain the invention. On this basis alone, the examiner has determined that element 16 in Mosier is "a target ball." As the applicant can not find an "element 16" disclosed by Mosier, the applicant assumes that the examiner is referencing target "23" or "52."

The examiner stated that the applicant did not state that a target ball is "critical" and, therefore, that a lack of such a statement opened the door to using the Mosier reference. The applicant's representative cautions that this expansive examination technique can lead to an unreasonable conclusion of what one of ordinary skill in the art would reasonably read from a reference. In the present case, it is unreasonable to believe that one of reasonable skill in the art would have read Mosier with its disclosure of a putting mat 23 having a target 52 and extrapolated the present recitation and claims regarding target and play balls. The applicant urges that his is an unreasonable reading of Mosier.

Now, with more specific reference to Mosier and the present application, the applicant will show that the examiner's statement concerning a lack of disclosure of the "critical" importance and intent of the target being a ball is incorrect. Although the word "critical" may not have been used, the importance and fundamental need for a target ball is well documented in the application. First, specific details regarding the target and how it is to be used are stated explicitly in the application. The structure of the target ball is described as "similar in size to a soccer ball." (Application, p. 1, line 19) Further, it is implicit that the target must be a ball in that it "may initially be kicked away from the players and club to begin a game." (Application,

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p. 1, lines 19-20). Intended usage of the target as evidence of its critical importance is also given repeatedly in the Abstract of the Disclosure. Still further, evidence of the criticality of the target being a ball is that a stated object of the invention is to strike respective play balls until they impact a target ball. (Application, page 2, lines 16-17). The criticality of the target ball is also
5 evidenced by its recitation in the preamble to the independent claims, namely, "A kit for use in playing a golf and soccer-like game. . . " It is difficult to imagine having a "soccer-like" game without having a ball. It is also difficult to imagine how prior art references having no disclosure of "soccer-like" game elements can support the present rejections of a "soccer-like" game, as will be further discussed below. Without admitting the propriety of these rejections, claims 1
10 and 12 have been amended to more perfectly distinguish over Mosier in that the target ball may be kicked away from a plurality of play balls and the club to start game play.

In clear contrast to the detailed disclosure of the original application, the Mosier patent is solely directed to a "target mat" without any suggestion that the target could be a ball. The Mosier disclosure, therefore, does not teach or even suggest that the target could be a ball.
15 More particularly, Mosier teaches a mat 23 and target 52 that are stationary and incapable of providing the same utility as the target ball in the present invention. The present invention, by contrast, teaches a target ball 12 that is to be kicked away from the play balls and club in order to start the game.

There are further implications to the fact that the Mosier reference teaches the use of
20 a stationary target mat. Specifically, Figs. 1, 4, 5, and 6 of Mosier show various embodiments of a stationary mat embodiment. Mosier, therefore, teaches that "the target" is a stationary mat-like object. It does not follow logically that these stationary "target" objects may be kicked,

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potentially long distances, away from a starting point so as to begin game play or that they would be otherwise useful for a soccer-like game. It has been held that a "reference will teach away if it suggests that the line of development from the reference's disclosure is unlikely to be productive of the result sought by the applicant." In re Gurko, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). This holding seems to be particularly on-point to the present situation. Namely, the Mosier disclosure presents at least three embodiments of stationary mat-like target elements and no disclosure, teaching, or suggestion of a ball-like or kickable target. Therefore, the applicant asserts that even a detailed study of the Mosier patent, whether by itself or with any other combination of the cited references, would not have produced the present invention including the target ball or the invention as a whole now recited in the claims. Accordingly, the applicant respectfully requests that the rejection of claims 1-6, 9, 12, 16, and 17 be reconsidered and withdrawn and that these claims be allowed. And, as will be reiterated below, the applicant believes that the Mosier reference should no longer be relied on with respect to any other rejections in the present examination.

Claims 10, 13, and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mosier in view of Urquhart, U.S. Pat. No.569,438 . The applicant urges the examiner to reconsider the propriety of this rejection in view of the comments and arguments made previously concerning Mosier. With Mosier being clearly distinguished, the present rejection is an improper combination. More particularly, claims 10 and 13 depend from claims 1 and 12, respectively, and it has been clearly shown above that Mosier does not teach or suggest, whether considered singly or in combination, a combination golf and soccer-like game having, amongst

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other things, a target ball that may be kicked away from a plurality of play balls and a club to start game play. Without admitting the propriety of these rejections, claims 1 and 12 have been amended to more perfectly recite this distinction over Mosier. Therefore, claims 10, 13, and 14, which depend from claims 1 and 12, should be in condition for allowance and such is
5 respectfully requested.

Claims 1-3 and 5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz, U.S. Pat. No. 5,383,665. Without admitting the propriety of the present rejection, claim 1 has been amended as described previously to more perfectly recite that the present invention
10 includes a target ball for being kicked away from a plurality of play balls and a club as was originally disclosed. It should be appreciated that claim 1 is clearly distinguished over Schulz for substantially the same reasons advanced previously regarding Mosier. Again, the examiner has not fully appreciated the importance of the present target as being a target ball despite the extensive disclosure of its fundamental importance in the original disclosure. Like the Mosier
15 reference, Schulz teaches only a stationary target 16 that is incapable of being kicked to a selected position away from a plurality of play balls and club. With no teaching or suggestion toward the present soccer-like invention, it surely must be concluded that Schulz teaches away from the present invention. To make this even more clear, claim 1 has been appropriately amended. For these reasons, claim 1 should be in condition for allowance and such is
20 respectfully requested along with claim 3 which depends therefrom.

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Claims 7 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz in view of Arkin, U.S. Pat. No. 3,829,092. Without admitting the propriety of these rejections, claims 7 and 8 have been canceled as discussed above.

5 Claims 10 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz in view of Urquart. The applicant contends that this rejection is also an improper combination in that claim 1, as amended, now clearly distinguishes over Schulz for all of the reasons advanced above regarding Schulz or Mosier. Therefore, claims 10 and 11, which depend from claim 1, should be in condition for allowance and such is respectfully requested.

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 Claims 4, 6, 9, 12, 16, and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz in view of Mosier. As clearly discussed above, neither Schulz nor Mosier disclose, teach, or suggest a combination golf and soccer-like game having a plurality of play balls, a club, and a target ball for being kicked to a position away from the play balls and club. As also discussed above, the original disclosure of the present application clearly presented the importance of the target being in a form that may be kicked to begin game play (e.g. a ball). Neither Schulz nor Mosier present any embodiments other than stationary targets and do not make any suggestions that would have led one of ordinary skill in the art to the present invention. For these reasons, the present rejections should be withdrawn and such is respectfully requested.

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 Claims 13 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz in view of Mosier and further in view of Urquhart. As discussed previously, the applicant

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urges that any combination utilizing Schulz or Mosier is an improper combination in that both references teach stationary targets that would not work in the present invention and which do not provide any teaching that would lead one of ordinary skill in the art to the present invention. Properly interpreted, the applicant believes these two references teach away from the present invention. Therefore, the applicant respectfully requests that these rejections be withdrawn and that claims 13 and 14 be allowed.

Claim 15 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz in view of Mosier and further in view of Arkin. Again, the applicant believes that claims 1 and 12 have been sufficiently amended to clearly distinguish over Schulz and Mosier such that claims depending therefrom, such as claim 15, should now be in condition for allowance. Such allowance, therefore, is respectfully requested.

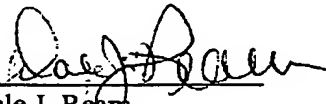
This application should now be in condition for allowance and such is respectfully requested. If the examiner has any suggestions that would place this application in even better condition for allowance, the examiner is invited to contact the applicant's representative at the telephone number listed below.

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Respectfully Submitted,

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